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EXAMINER
PHAN, JOSEPH T

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/782,772	KOVALES ET AL.
	Examiner	Art Unit	
	Joseph T. Phan	2614	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
> - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>01 August 2008</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1,3,6-14,17-33,35,37-41,44-58,61-68 and 71-88_ is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1, 3, 6-14, 17-33, 35, 37-41, 44-58, 61-68, 71-88_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a)☐ All   b)☐ Some * c)☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 08/01/2008 have been fully considered but they are not

persuasive. Applicant contends that the prior art of record does not disclose creating a

bookmarked message from the voicemail message and the bookmarks, however this newly added

limitation is found in Hamel(see 110 and 120a of Fig.2D).

Claim Rejections - 35 USC § 112

2.   Claims 29-32, 53-56 and 59 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

   Claims 29-32, 53-56 and 59 depend on cancelled claims which causes the claims to be

indefinite. Appropriate clarification and/or correction is required.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

   1.   Determining the scope and contents of the prior art.
   2.   Ascertaining the differences between the prior art and the claims at issue.
   3.   Resolving the level of ordinary skill in the pertinent art.

      4.   Considering objective evidence present in the application indicating obviousness
           or nonobviousness.

5.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

     Claims 1, 3, 6-7, 12-14, 17-20, 22-33, 35, 37, 41, 44-47, 49-58, 61-62, 67-68, 71-72, 74-

81, and 83-88 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel et al.,

Patent #5943402 in view of Valco et al., Patent #6442243.

     Regarding claims 1, 33, and 57, Hamel teaches a method, system and computer readable

medium providing bookmarks for a voice mail message by a caller leaving the voice mail

message(col.2 lines 12-21); and

creating a bookmarked message from the voice mail message and the bookmarks(110 and 120a

of Fig.2D), wherein at least two of the bookmarks are used to mark respective segments of the

voice mail message(Fig.3A-3B), and wherein at least some of the bookmarks correspond to

respective topics (col.1 line 55-col.2 line 21; it is noted the term 'some' can be one).

     Hamel is silent on disclosing the bookmarks corresponds to topics and segments having

different ones of the degrees of importance.

     However, Valco teaches bookmarks having topics and different ones of degrees of

importance(Valco col.12 lines 55-59).

In the same field of endeavor of a caller managing voicemails, It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hamel's marked segments(Fig.3A) to include different ones of the degrees of importance as taught by Valco in order to distinguish the segment as urgent or not as this would allow a more efficient way to manage voicemails.

Furthermore, Hamel expressly discloses that a prior art voicemail system, Valco is one, can be used to manipulate Hamel's voicemail system(col.2 lines 3-12) and therefore further establishes the prima facie combination.

It is also noted that Valco uses the same standard twelve key touch tone telephone keypad as suggested by Hamel(col.2 lines 19-21 and col.3 lines 6-10) for marking to further simplify the combination.

Regarding claims 3 and 35, Hamel in view of Valco teaches the method and system according to claims 1 and 33, further comprising means for playing the bookmarked message to a listener(85 Fig.2C, 110 and 120a of Fig.2D).

Regarding claims 6 and 61, **Hamel** in view of Valco teaches the method, system and computer readable medium according to Claims 1, 37, and 57 wherein a default degree of importance is associated with at least one of the respective segments (Valco col.12 lines 55-59).

Regarding claims 7, 37, and 62, **Hamel** in view of Valco teaches the method, system and computer readable medium according to claims 1, 33, and 57 wherein at least one of the bookmark corresponds to one or more special types of information in the voice mail message (Valco col.12 lines 55-59).

Regarding claim 67 **Hamel** in view of Valco teaches a computer readable medium

according to claim 59 further comprising code configured to use the at least one bookmark to

navigate from one topic of the voicemail to another(*col.3 lines 16-55, col.4 lines 55-67, col.5

lines 16-48, and col.8 lines 35-67*).

     Regarding claims 13, 40, and 66 **Hamel** in view of Valco teaches the method according

to claim 7, wherein at least one of the special types of information is a protection or

confidentiality indicator message (Valco col.12 lines 55-59; private is confidential).

     Regarding claim 14, 41, and 68, **Hamel** in view of Valco teaches a method, system and

computer readable medium according to claims 2, 34, and 58 further comprising the step of

using the at least one bookmark to perform actions selectively on one or more segments of the

voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67;

listening to the segment is an action*).

     Regarding claims 17, 47, and 72 **Hamel** in view of Valco teaches a method, system and

computer readable medium according to claims 14, 41 and 68, wherein the selected respective

segments are associated with one or more special types of information in the voice mail

message(*col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

     Regarding claim 18, 44, and 71, **Hamel** in view of Valco teaches a method, system and

computer readable medium according to claims 14, 41, and 68, wherein the actions comprise one

or more of saving, deleting, forwarding, listening, skipping, or repeating one or more of the

selected respective segments, and marking a particular segment as protected or confidential prior

to forwarding the marked segment to another party (Valco *col.12 lines 55-59*).

     Regarding claim 19 and 45 **Hamel** in view of Valco teaches a method, system and

computer readable medium according to claims 18 and 44, wherein the actions further comprise

marking at least one of the selected segment as protected or confidential (Valco *col.12 lines 4-7 and 55-59).*

Regarding claim 20 and 46 **Hamel** in view of Valco teaches a method, system and computer readable medium according to claims 19 and 45 further comprising forwarding the segment marked as protected or confidential to another party *(Valco col.11 lines 45-55 and col.12 lines 55-59).*

Regarding claim 22 **Hamel** in view of Valco teaches the method according to claim 1, wherein the creating step further comprises storing the bookmarks and the voice mail message separately as the bookmarked message *(Hamel 85 Fig.2C, 110/120a of Fig.2D).*

Regarding claim 23 **Hamel** in view of Valco teaches the method according to claim 2 wherein the creating step further comprises storing the bookmarks and the voice mail message intermingled as the bookmarked message*(Hamel 85 Fig.2C, 110/120a of Fig.2D).*

Regarding claims 24, 49, and 74 Hamel in view of Valco teaches a method, system and computer readable medium according to claims 3, 35, and 58, further comprising announcing for the bookmarked voice mail message, a number of the bookmarked segments in the voicemail message *(Valco col.5 lines 21-38, Hamel col.5 lines 16-48, and col.8 lines 35-67).*

Regarding claims 25-26, 50, 75, 83-86 Hamel in view of Valco teaches a method, system and computer readable medium according to claims 1, 3, 7, 33, 35, 37, 58, 60, and 62 further comprising announcing, before, during, or after playing the voicemail message, the different degree of importance in the voice mail message and a number of segments thereof*(Valco col.5 lines 21-38, Hamel col.5 lines col.5 lines 22-48, col.7 lines 1-8, and col.8 lines 35-67; displaying is also announcing).*

Regarding claims 27, 51, 76, 87-88 Hamel in view of Valco teaches a method, system and computer readable medium according to claims 3, 5, 7, 35, 37, 43, 58, 60, and 62 further comprising announcing, before and after playing the voicemail message, the special types of information in the voicemail message*(Valco col.5 lines 21-38, Hamel col.5 lines col.5 lines 22-48, col.7 lines 1-8, and col.8 lines 35-67; displaying is also announcing).*

Regarding claims 28, 52, and 77 **Hamel** in view of Valco teaches the method, system and computer readable medium according to claims 7, 37, and 62 wherein particular ones of the special types of information are required, and further comprising the step of prompting the caller to provide input for each particular one for which no bookmark is otherwise provided*(col.5 lines 16-48, and col.8 lines 35-67, Valco col.5 lines 21-38).*

Regarding claims 29, 53, and 78 **Hamel** in view of Valco teaches the method, system and computer readable medium according to claim 58 further comprising the step of associating one or more audio cues with one or more bookmarks of the voice mail message*(col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67).*

Regarding claims 30, 54, and 79 **Hamel** in view of Valco teaches the method, system and computer readable medium according to claims 29, 53, and 78 further comprising the steps of playing the bookmarked message to a listener; and incorporating the one or more associated audio cues along with respective portions of the voice mail message corresponding to the one or more bookmarks *(col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67).*

Regarding claims 31, 55, and 80 **Hamel** in view of Valco teaches the method, system and computer readable medium according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue

with its respective portion of the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67).*

Regarding claims 32, 56, and 81 **Hamel** in view of Valco teaches the method, system and computer readable medium according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue in-line with its respective portion of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67).*

6.   **Claims 8-10, 12, 38, 40, and 63-66 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel in view of Valco further in view of Parsons et al., Patent #6,970,906.**

Regarding claims 8-10, 12 38, 40, and 63-66 **Hamel** in view of Valco teaches the method, system and computer readable medium according to claims 7, 37, and 62.

Hamel is silent about disclosing wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator.

However, in the same field of endeavor of managing voicemails, Parsons teaches wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator(Parsons *col.6 lines 16-35 and col.9 lines 49-57).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hamel's marked segments(Fig.3A) to include a callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator(Parsons col.6 lines 16-35) as this would allow a more efficient way of handling voicemails.

Furthermore, Hamel expressly discloses that a prior art voicemail system, e.g. Parsons, can be used to manipulate Hamel's voicemail system(col.2 lines 3-12) and therefore further establishes the prima facie combination.

6.   **Claims 11, 21, 39, 48, and 73 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel in view of Valco further in view of Haddock, Patent #5,742,736.**

Regarding claims 11, 21, 39, 48, and 73 **Hamel** in view Valco teaches a method, system and computer readable medium according to claims 17, 37, 47, and 72.

Hamel is silent on wherein at least one of the special types of information comprises a uniform resource locator(URL) and where at least one of the actions comprises automatically establishing a connection to the URL.

However, in the same field of endeavor, Haddock teaches viewing and manipulating voice mail messages on a computer display and the contents thereof can be retrieved and connected to applications on the computer (col.4 lines 38-54).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include a computer display like in Haddock to view and access information within voice mail messages as taught in Hamel(col.1 lines 45-52).

One of ordinary skill in the art would have been motivated to do this as automatically connecting to a URL via a displayed hyperlink is old and well-known in the art and since Haddock's user is able to use information(e.g. phone #, points of interest, etc.) to automatically establish a connection to it, URL's are just an example of points of interest that can be accessed with a computer application(e.g. "Internet Explorer").

Furthermore, Hamel expressly discloses that features in a prior art voicemail system, e.g. Haddock, can be used to manipulate Hamel's voicemail system(col.2 lines 3-12) and therefore further establishes the prima facie combination.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 8:30am-6pm EST, off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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/Joseph T Phan/
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